

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of
KLOSTERS

Atty. Docket
NL02 1019 US

Serial: 10/531,399

Group Art Unit: 2183

Filed: 04/14/2005

Examiner: FONG, VINCENT

DATA PROCESSING APPARATUS THAT PROCESSES INCOMING BITS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Sir:

Responsive to the Examiner's Answer of 06/26/2008, Applicant replies as follows.

Broadest Reasonable Interpretation is Not the Same as Broadest Possible Interpretation

The Examiner's Answer repeatedly makes the point that the rejection is entitled to give the claims their broadest reasonable interpretation. This principle, however, does not negate the fact that claim terms are construed as they would be by one of ordinary skill in art—*not in a technical vacuum*.

This caveat is clearly set forth in MPEP 2111, excerpts from which follow:

[T]he PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage *as they would be understood by one of ordinary skill in the art*, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification. (Citing *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997), emphasis added.)

* * *

The broadest reasonable interpretation of the claims must also be *consistent with the interpretation that those skilled in the art would reach*. (Citing *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999), emphasis added.)

In a Technical Context, the Rejection's Interpretation is Not Reasonable

In a nutshell, the rejection takes the position that operation of a dedicated, hardwired digital circuit (“state machine”) qualifies, given the broadest reasonable interpretation, as the “execution of instructions.” Similarly, that the circuit is “programmable,” and that inactivity of the circuit qualifies, given the broadest reasonable interpretation, as “suspending execution.” Each of these positions ignores the provisions of MPEP 2111 as cited above.

Fundamentally, one of ordinary skill in the art would not interpret “execution of instructions” so broadly as to encompass the operation of a dedicated, hardwired digital circuit. Such an interpretation, while it may sound plausible in a technical vacuum or by way of analogy, contradicts the technical understanding of one of ordinary skill in art.

Applicant asserts that it would not occur to one of ordinary skill in the art that the “execution of instructions” as understood in the art might be taken to mean the operation of a dedicated, hardwired digital circuit. The execution of instructions unavoidable connotes the use of a general-purpose or special-purpose processor that is “programmable,” i.e., that can be readily programmed and reprogrammed to perform different functions (or at least readily programmed to accomplish a desired function from among a range of possible functions). A dedicated, hardwired digital circuit conspicuously lacks these attributes.

The Examiner’s Answer asserts that the dedicated, hardwired digital circuit is “one-time programmable.” One of ordinary skill in the art would, Applicant submits, disagree. “Programmable” connotes programmable with relative ease. In the case of the dedicated, hardwired digital circuit, the best that can be said is that it is “designable,” not with considerable ease but with considerable effort.

The same point may be made with respect to other claim features mentioned above (e.g., “suspending execution”). One of ordinary skill in the art would not find these terms applicable to a dedicated, hardwired digital circuit.

Conclusion

From the foregoing, it may be seen that the rejections should be reversed as not being in accordance with the provisions and guidance of MPEP 2111.

Respectfully submitted,

/Michael J. Ure/

Michael J. Ure, Reg. 33,089

Dated: 08/19/2008